

REMARKS

This application has been carefully reviewed in view of the above-referenced Office Action, and reconsideration is requested in view of the following remarks.

Regarding all Prior Art Rejections

By way of review, the prior Office Action indicated that claims 1-29 are currently pending. Claims 1, 15, 26 and 28 are amended. Support for the amendments may be found in page 11 of the instant specification. Claims 1-29 stand rejected.

Regarding the Rejections under 35 USC 112

The claim amendments to claim 26 place the claim in proper format according to 35 USC 112, sixth paragraph. Accordingly, reconsideration is respectfully requested.

Regarding the Rejections under 35 USC 102(e)

Claims 1-4, 6-14, 16-18, and 20-29 are rejected under 35 USC 102(e) as being anticipated by Flickinger et al. (US Patent Publication 2005/0210502, hereinafter "Flickinger") based on provisional 60/229,156 (hereinafter "Provisional") filed on August 31, 2000. These rejections are respectfully traversed.

The Office Action seems to assert that it is proper to apply a rejection under 35 USC 102(e) using multiple references citing MPEP 2131.01 in support. However, MPEP 2131.01 recites that a rejection under 35 USC 102 using multiple references is proper if the secondary reference is used only to show that the primary reference contains an "enabled disclosure." As shown in *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985) an "enabled disclosure" must "show that the claimed subject matter, as disclosed in Nomura, was in the public's possession" prior to the filing of the instant application. However, *Donohue* also discloses that "an anticipation rejection requires a showing that each limitation of a claim must be found in a single reference" and that the secondary references may not be relied upon to impute limitations not found in the principal reference, in this case Flickinger, into that reference. Thus, the Office

Application No.: 10/822,891

Action by this reliance upon a 102 rejection utilizing multiple references seems to assert that every element of the rejected claims is found in a single reference, Flickinger, and that the elements not found in Flickinger are in the public's possession by being disclosed in the second reference (Provisional 60/229,156). However, they are not.

Regarding claims 1, 15, 26 and 28, claim 1 recites at least "receiving data representing video content, the data having at least first and second packet identifiers (PIDs) associated with a first and a second macroblock of main content" and "substituting the macroblock having the second PID for the macroblock having the first PID comprising substituting a macroblock of main content with a macroblock that comprises substitution content data", claims 15 and 26 recite at least "the data having at least primary and secondary packet identifiers (PIDs) associated with a first macroblock of main content and a second macroblock of substitution content", and claim 26 recites at least "means for receiving input data representing at least one macroblock of main content", "means for receiving input data representing at least one macroblock of substitution content" and "means for assembling the private data, the main content mapped to the primary PID and the substitution content mapped to the secondary PID into a data stream."

The disclosure in both the Flickinger reference and the Provisional reference refers to inserting ready made advertising content into "avails" left open for such advertisements in the incoming content stream. The Provisional reference discloses on Page 30, paragraph 4, that "ads would be decoded and inserted into the avail of the analog programming, the substituted video stream being sent to the display device." This disclosure does not provide a disclosure for using macroblocks of data to produce main content for display or substitution and does not place this disclosure within the public domain. Thus, the Provisional reference does not provide the evidence to place this feature of claims 1, 15, 26, and 28 within the public domain, and thus there is no evidence for an enabled disclosure within Flickinger for the recited elements of the above claims.

In addition, Flickinger does not anticipate claims 1, 15, 26 and 28 as it does not provide a disclosure for each element of these claims. The Flickinger reference discloses that "avails", which, once again, are non-main content openings in the data stream into which ready made video advertising content may be inserted, may be made available for any of a number and

Application No.: 10/822,891

variety of advertisements. However, Flickinger discloses "the invention provides an ad storage and filtering system for selectively identifying targeted ads to be stored in memory of the STB", which discloses that these advertisements are pre-made and placed in storage until such time as they are called forth to be inserted directly into an avail, so as not to disturb the main content of the video content stream. This is not the same as the features recited in claims 1, 15, 26, and 28, where main content within the video content stream is constructed from macroblocks and inserted into the main content stream, either replacing or augmenting the content stream, without being restricted to "avail" locations within the content stream. Thus, the Provisional reference fails to provide evidence of an enabled disclosure for Flickinger, and the Flickinger reference does not provide the disclosure of each element of the claims necessary to anticipate the recited features of claims 1, 15, 26 and 28. Reconsideration and early allowance are respectfully requested.

Regarding claims 2-4, 6-14, 16-18, 20-25, 27, and 29, each of these claims depends from one of independent claims 1, 15, 26 or 28. In view of the above, it is clear that Flickinger fails to establish anticipation of these claims. The dependant claims are, therefore, allowable for at least the reasons shown for claims 1, 15, 26, and 28. Accordingly, reconsideration and allowance are respectfully requested.

Regarding the Rejections under 35 USC 103(a)

Claims 5, 15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flickinger et al. (US Patent Publication Number 2005/0210502, hereinafter "Flickinger") in view of Provisional 60/229,156 (hereinafter "Provisional"). The Flickinger reference relates to a system and method for an ad storage and filtering system for selectively identifying targeted ads to be stored in memory of the STB. The Provisional reference relates to a system and method for addressable and program independent advertising content insertion. These rejections are respectfully traversed.

Application No.: 10/822,891

Regarding claims 5, 15 and 19, claim 15 recites at least "the data having at least primary and secondary packet identifiers (PIDs) associated with a first macroblock of main content and a second macroblock of substitution content", and "receiving an initiation flag indicating initiation of a PID mapping operation." Claims 5 and 19 recite "substitution criterion is met as a result of receipt of a flag."

The Office Action admits on page 14 that the Flickinger reference does not disclose or teach a method of content substitution wherein the substitution criterion is met as a result of receipt of a flag. The Office Action seems to assert that the Flickinger reference discloses that the placement of an indicator for a location where substitution of content may start and end discloses this feature and seems to assert that substitution as the result of the receipt of a flag is disclosed by the Flickinger reference in paragraph [0041], however, it is not.

The Flickinger reference does not provide the disclosure for the receipt of a flag as the substitution criteria. The reference, in paragraph [0041], discloses only that "Preferably, the information stream includes particular time intervals which are dedicated for insertion of such external data", which teaches away from the use of flags for indicating the location of data insertion points because these insertion points are "preferably" based upon locating avails based upon timing, not flags. Therefore, the Flickinger reference does not provide the disclosure necessary to render claims 5, 15 and 19 obvious. In view of this shortcoming in the rejection and failure to articulate reasoning to explain why the claims are obvious in view of a lack of such disclosure, the Office Action further fails to establish *prima facie* obviousness. For these reasons, reconsideration and allowance of claims 5, 15 and 19 is respectfully requested.

Applicant makes no admission or concessions as to the accuracy of the Office Action's positions on any other matters and reserves the right to make other arguments at a later date if appropriate, but feels that the present arguments are more than adequate to address all rejections at present.

Interview Request

In view of this communication, all claims are now believed to be in condition for

Application No.: 10/822,891

**RECEIVED
CENTRAL FAX CENTER****JUL 07 2008**

allowance and such is respectfully requested at an early date. If further matters remain to be resolved, the undersigned again respectfully requests the courtesy of an interview. The undersigned can be reached at the telephone number below.

Respectfully submitted,

/Jerry A. Miller 30779/

Jerry A. Miller
Registration No. 30,779
Dated: 7/07/2008

Please Send Correspondence to:
Miller Patent Services
2500 Dockery Lane
Raleigh, NC 27606
Phone: (919) 816-9981
Fax: (919) 816-9982
Customer Number 24337

Application No.: 10/822,891

-11-